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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/530,167	04/24/2000	CLAUS GODER	GK-GEY-1065	2203

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EXAMINER

FARAH, AHMED M

ART UNIT	PAPER NUMBER
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3739

DATE MAILED: 02/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Harry Alan
(212) 521-5433

Office Action Summary

Application No. 09/530,167	Applicant(s) Goder et al.
Examiner A. Farah	Art Unit 3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on Nov 21, 2002

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) Claim(s) 22-42 is/are pending in the application.

4a) Of the above, claim(s) 39-42 is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 22-38 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. _____.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892)

4) Interview Summary (PTO-413) Paper No(s). _____

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

5) Notice of Informal Patent Application (PTO-152)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s). 7

6) Other: _____

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DETAILED ACTION

Election/Restriction

1. Claims 39-42 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 5.
2. This application contains claims 39-42 drawn to an invention nonelected with traverse in Paper No. 5. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper tames extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In*

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re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 22-38 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims ¹⁻⁴ ~~14~~ and 16-33 of copending Application No. 09/762,834. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are directed to analogous medical device and methods for treating biological tissue, the device comprising a microoptically active structure for modify the cross section and intensity of a laser light directed to the tissue being treated.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 22-38 rejected under 35 U.S.C. 103(a) as being unpatentable over Telfair et al. U.S. Patent No. 4,911,711 in view of Elbrecht et al. WO 00/10049.

Telfair et al. disclose ophthalmic surgery apparatus for reshaping the surface/curvature of the cornea to correct vision defects. As shown in Figures 1, 2, and 8, the surgical apparatus comprises:

- A) a pulsed excimer laser 11;
- B) a beam deflecting device 25 (Col. 4, line 34), through which the laser beam is guided over the surface of the eye 13; and
- C) an optical element 22 for changing the distribution of the radiation intensity inside the laser beam cross-section, the optical element 22 including at least one optical device (trap 21) with optically active structure, wherein the optically active structure influences the intensity distribution of the laser beam cross-section in such a way that the laser beam, after passing through optical element 22, has a Gaussian intensity distribution (see Col. 3, line 47 to Col. 4, line 17).

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In reference to claim 23, trap **21** of Telfair et al. is provided with a diffractive and/or refractive optically active structure. As shown in Fig. 2, trap **21** is introduced into or removed from the path of the laser beam.

In reference to claims 24-27, the invention of Telfair et al. is directed to methods for shaping and homogenizing the intensity inside the cross-section of a rectangular laser pulse from ultraviolet excimer laser so as to produce a circular laser beam with a Gaussian intensity distribution that is suitable for reshaping the cornea (see claim 1 and the abstract).

In reference to claims 28-32, the surgical apparatus of Telfair et al. comprises a plurality of optical elements including: optical elements (filters **24**), which are arranged on a movable carrier (rotatable wheel **56**); a rotatable disc **66**, which is placed in the optical path of the laser beam so as to influence the size of the spot area directed on the cornea; and a computer **30**, which controls the functions of the optical elements.

In reference to claims 33 and 34, the computer **30** of Telfair et al. is coupled to a surface diagnostics device **17**, and thereby detects the actual values/curvature of the corneal surface.

However, although the optical device (trap **21**) of Telfair et al. is optically active in the micron range and modifies the cross section and intensity of the laser beam as presently claimed, the applicants argue that trap **21** has no optical element with a microoptically active structure.

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Elbrecht et al. teach an alternative medical laser device comprising a light transparent disc 3 with microoptically active surface 4 (see the abstract and Fig. 1), wherein the surface 4 has a diffractively acting structure whose width roughly corresponds to the wavelength of the laser beam utilized for the treatment. The diffractively acting structure is constructed with: a varying height profile of various shapes, a varying index of refraction, and a varying absorption coefficient. Their microoptically active structure changes the cross section and the intensity profile of the laser beam as presently claimed.

Therefore, since the device of Telfair et al. modifies the cross section and the intensity of the laser beam, it would have been obvious to one skilled in the art at the time of the applicants' invention to modify Telfair et al. with Elbrecht et al. to use a microoptically active element as an equivalent alternative element in order to modify the cross section and the intensity of the laser beam as presently claimed. As to claims 35-38, the apparatus of Telfair et al. in view of Elbrecht et al. would inherently provide the methods as claimed.

Response to Arguments

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a diffractively active element structured in the micrometer range whose dimensions

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roughly correspond to the wavelength of laser beam utilized for the treatment) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Furthermore, in this Office Action, the term "microoptically active structure" in the claims is treated as broadly as claimed. Hence, any diffractive element such as diffraction grating whose dimensions are structured in the micrometer range is treated as a 'microoptically active structure.' It required that the applicants clearly describe this limitation in the claims and/or the specification.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patent 6,086,204 to Magnante and U.S. Patent 5,146,917 to Wagnieres et al. disclose medical treatment devices comprising microlenses, respectively. U.S. Patent 5,463,200 to James et al. discloses a technique for marking a workpiece using diffractive optics, including an array of microlenses.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to A. Farah whose telephone number is (703) 305-5787. If attempts to reach the examiner by telephone are unsuccessful, the examiner's

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supervisor, Ms. Linda Dvorak, can be reached on (703) 308-0994. The fax number for the Examiner is (703) 746-3368.



Linda C. M. Dvorak

A. M. Farah

Patent Examiner (Art Unit 3739)



February 6, 2003

Supervisory Patent Examiner